

REMARKS/DISCUSSION OF ISSUES

Claim Summary

By this Amendment, claims 1-6 have been amended to correct informalities in the claim language and to more clearly define the invention, as discussed below. Further, claims 7-15 have been submitted for the Examiner's consideration.

Claims 1-15 are pending in the application. Applicant respectfully submits that all pending claims are in condition for allowance.

Allowable Claims

Applicant notes with appreciation that the Examiner has indicated the allowability of claim 3, if rewritten in independent form including all of the limitations of the base claim. Applicant notes that the rejection of independent claim 1, from which claim 3 depends, has been traversed, as discussed below. However, without acquiescing to the Examiner's rejection of claim 1, Applicant has submitted new claim 7, which substantially includes the subject matter of allowable claim 3 rewritten in independent form.

Accordingly, Applicant respectfully requests allowance of claim 7, as well as newly submitted claims 8 and 9, which depend from claim 7.

Specification

Paragraph [0020] of the specification has been revised to correct minor informalities. No new matter has been added to the applications by these revisions.

35 U.S.C. § 103 Rejection - Claims 1 and 2

The Office Action of January 2, 2008, rejects claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over CLARK, Jr. (U.S. Patent No. 4,268,718), and AMTMANN et al. (U.S. Patent No. 6,995,651), and SUGIYAMA et al. (U.S. Patent No. 6,763,120). Applicant respectfully traverses the rejection because no proper combination of CLARK, Jr., AMTMANN et al. and SUGIYAMA et al. teaches or suggests all limitations of the claims.

As stated in MPEP § 2143, in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant's silence on certain aspects of the rejection is by no means a concession as to their propriety. Rather, because the applied art fails to disclose at least one feature of the claims, for at least the reasons discussed below, Applicant respectfully submits that the rejections are improper and should be withdrawn.

Claim 1

Claim 1 recites, in part: "a circuit unit, comprising a circuit substrate and at least one circuit component of a signal-processing circuit, the circuit component being mounted on the circuit substrate, wherein the sound-generating means define an interior space, which is accessible from outside the sound-generating means when the transducer is being manufactured and before the circuit unit is fitted, and wherein the at least one circuit component is positioned within the interior space defined by the sound-generating means and forms a communication circuit of a communication partner device for contactless communication."

Initially, with respect to at least the primary reference, Applicant notes that the Examiner has not identified specific elements of CLARK, Jr., which disclose the various features recited in claim 1. *See* Office Action, pp. 2-4. The rejection of claims 1 and 2 (as well as the rejections of other claims depending from claim 1) therefore fails to comply with a basic tenet of patent examination.

MPEP § 706 states, in part: "The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Respectfully, Applicant submits that the Office Action does not clearly cite that which the

Examiner alleges to teach sound-generating means, an interior space defined by the sound-generating means, a circuit substrate, and/or at least one circuit component of a signal-processing circuit in the applied art. Thus, Applicant is left to ponder that which may be considered by the Examiner to be these elements. Clearly, such uncertainty places Applicant in the prejudicial position of having to base a reply on potentially incorrect assumptions.

Therefore, Applicant respectfully submits that the present rejection is improper and should be withdrawn. Moreover, if the shortcomings noted above are remedied in future official correspondence, any such rejections should be provided in a subsequent non-final Office Action. However, in the interest of moving prosecution forward, and without waiving any objections to the Office Action, Applicant has addressed the rejections to the extent possible, below.

The Office Action asserts that CLARK, Jr. discloses the sound-generating means and the circuit unit, as recited in claim 1. *See* Office Action, p.2. As discussed above, the Examiner has not identified the specific elements of CLARK, Jr., so Applicant assumes that the Examiner intended to rely on the sound transducer 34, the printed circuit board 22 and the integrated circuit chip 24 of CLARK, Jr. to teach the sound-generating means, the circuit substrate and the at least one circuit component, recited cited in claim 1, respectively. The sound transducer 34, in particular, “receives a transmitted data signal and converts the data signal into an electrical information signal,” and includes “an output port 36 through which the audio output signals are emitted.” Col. 2, lines 62-65; col. 3, lines 1-3. However, as shown in FIG. 1, the sound transducer 34 clearly does not “define an interior space,” such that “the at least one circuit component is positioned within the interior space.” Rather, the sound transducer 34 and the integrated circuit chip 24 are separately located from one another on different portions of the printed circuit board 22. CLARK, Jr. therefore does not teach or suggest at least these claim features.

The Office Action relies on AMTMANN et al. only to teach means for a contactless communication and SUGIYAMA et al. only to teach the sound generating means being annular in form and surrounding an interior space. *See* Office Action, p. 3. Therefore, AMTMANN et al. and SUGIYAMA et al. do not cure the deficiencies of CLARK, Jr.

Accordingly, withdrawal of the rejection of claim 1 based on the combination of CLARK, Jr., AMTMANN et al. and SUGIYAMA et al. is respectfully requested.

Claims 2

With regard to claim 2, Applicant asserts that it is allowable at least because it depends independent claim 1, which Applicant submits has been shown to be allowable, as well as in view of its additional recitations.

35 U.S.C. § 103 Rejection – Claim 5

The Office Action of January 2, 2008, rejects claim 5 under 35 U.S.C. § 103(a) as being unpatentable over CLARK, Jr., and AMTMANN et al., and SUGIYAMA et al., and further in view of BLEIM et al. (U.S. Patent No. 6,370,257). Applicant respectfully traverses the rejection because no proper combination of CLARK, Jr., AMTMANN et al., SUGIYAMA et al. and BLEIM et al. teaches or suggests each and every element of the claim.

In particular, claim 5 depends from claim 1, and is therefore allowable for at least the reasons discussed above with respect to claim 1, as well as in view of its additional recitations. Further, the Examiner relied on BLEIM et al. only to teach a circuit unit arranged to be removable without the use of a separate tool. *See* Office Action, p. 4. BLEIM et al. therefore does not cure the deficiencies, discussed above, with respect to the combination of CLARK, Jr., AMTMANN et al. and SUGIYAMA et al.

35 U.S.C. § 103 Rejection – Claims 4 and 6

The Office Action of January 2, 2008, rejects claims 4 and 6 under 35 U.S.C. § 103(a) as being unpatentable over CLARK, Jr., and AMTMANN et al., and SUGIYAMA et al., and further in view of Official Notice. Applicant respectfully traverses the rejection because no proper combination of CLARK, Jr., AMTMANN et al., SUGIYAMA et al. and the Official Notice teaches or suggests each and every element of the claims.

In particular, claims 4 and 6 depend from claim 1, and are therefore allowable for at least the reasons discussed above with respect to claim 1, as well as in view of their additional

recitations. Further, the Examiner relied on the Official Notice only to teach four contact terminals (claim 4) and a transducer having a cup-shaped housing whose height in the direction in which a transducer axis is oriented is between 2 and 5 mm and whose diameter perpendicular to the direction in which the transducer axis is oriented is between 6 and 20 mm (claim 6). *See* Office Action, pp. 5-6. The Examiner's assertion of Official Notice therefore does not cure the deficiencies, discussed above, with respect to the combination of CLARK, Jr., AMTMANN et al. and SUGIYAMA et al.

Claims 10-15

Newly submitted claim 10 is allowable at least for substantially the same reasons discussed above with respect to claim 1. With regard to claims 11-15, Applicant asserts that they are allowable at least because they depend from independent claim 10, as well as in view of their additional recitations, respectively.

CONCLUSION

In view of the foregoing explanations, Applicant respectfully requests that the Examiner reconsider and reexamine the present application, allow claims 1-15 and pass the application to issue. In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact Van C. Ernest (Reg. No. 44,044) at (571) 283.0720 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment (except for the issue fee) to Deposit Account No. 50-0238 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17, particularly extension of time fees.

Respectfully submitted,

VOLENTINE & WHITT

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By: Van C. Ernest/
Van C. Ernest
Registration No. 44,099

VOLENTINE & WHITT, PLLC
One Freedom Square
11951 Freedom Drive, Suite 1260
Reston, Virginia 20190
Telephone No.: (571) 283.0724
Facsimile No.: (571) 283.0740